

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Harry Morris et al.	Art Unit :	2151
Serial No. :	09/690,007	Examiner :	Kamal B. Divecha
Filed :	October 17, 2000	Conf. No. :	1832
Title :	DISPLAYING ADVERTISEMENTS IN A COMPUTER NETWORK ENVIRONMENT		

Mail Stop Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the Action mailed January 17, 2007, Applicants elect the invention of Group I, which includes claims 1-28, 64-69, and 71-74. The election is made with traverse.

The Restriction Requirement indicates that “there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification.” See Action of January 17, 2007 at pages 3-4. However, for the following reasons, it is apparent that no such serious burden exists and, thus, the Restriction Requirement is improper.

The Restriction Requirement sets forth that claims 1-28, 64-69, and 71-74 (Group I) belong to class 709, subclass 224, while claims 55-57 and 70 (Group II) are classified in class 709, subclass 238. See Action of January 17, 2007 at pages 3-4. However, in a previous Restriction Requirement mailed December 15, 2003, the Examiner indicated that “Claims 1-28 and 55-57 are drawn to user monitoring and [are both] classified in class 709, subclass 224.” See Action of December 15, 2003 at pages 2. Because the Examiner previously indicated that claims 1 and 55 (which are representative of the current Groups I and II) fell within the same classification, and is only now indicating that they fall into different classifications, the Examiner has not provided an “appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.” See MPEP § 803. As such, the Examiner has failed to establish a serious burden due to the inventions being independent or distinct. Thus, the Restriction Requirement is improper.

In response to the previous Restriction Requirement of December 15, 2003, Applicants elected Group I, which included claims 1-28 and 55-57. See Response to Restriction Requirement mailed January 13, 2004 at page 1. As such, the Examiner has already searched and examined both claims 1 and 55. Indeed, since the filing of the present application, five Office Actions have been issued, each of which has provided a prior art rejection of both claims 1 and 55. See Office Actions mailed February 6, 2004, July 28, 2004, June 17, 2005, December 28, 2005, and May 31, 2006. Based on the extensive number of times the Examiner has already searched and examined claims in both Group I and Group II during the prosecution of this application, it is evident that there is no serious burden to examine these groups together.

According to the MPEP, “if the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” See MPEP § 803. As such, because there is no serious burden on the Examiner to search claims from both Groups I and II, as discussed above, Applicants respectfully assert that the Restriction Requirement is improper and the Examiner “must examine [the claims] on the merits.”

Moreover, the MPEP highlights that “a restriction requirement will normally be made before any action upon the merits; however, it may be made at any time before final action. See MPEP § 811. Section 811 goes on to indicate that “this means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops.” See MPEP § 811. Clearly, setting forth a Restriction Requirement at this point in prosecution, more than 6 years after the filing of this application and presentation of the claims at issue, is not “before any action upon the merits” nor is it “as early as possible” or even “as soon as the need for a proper requirement develops.” Both claims 1 (Group I) and 55 (Group II) have been pending in some form since the filing of this application, and, therefore, there is no argument to be made that “the need for a proper requirement” has recently developed.

Furthermore, the MPEP requires that “before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.” See MPEP § 811. As discussed above, the present Restriction Requirement is clearly “after the first action on the merits.” However, as also discussed above,

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there is no serious burden on the Examiner in searching and examining claims in both Groups I and II. Therefore, no circumstances exist that would allow for a Restriction Requirement at this extremely late stage of prosecution. As such, the Restriction Requirement is improper as it is extremely untimely.

For at least the reasons discussed above, Applicants respectfully traverse the Restriction Requirement.

No fee is believed to be due. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 2/16/07

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